

REMARKS

This Application has been reviewed in light of the Office Action mailed August 25, 2005. Claims 1-55 were rejected in the Office Action. Applicants amend Claims 1, 13-14, 15-17, 24-25, 33-34, 41-43, 48-49, and 52-55. Applicants respectfully request reconsideration and allowance of all pending Claims 1-55.

Claim Language

The Office Action does not consider the claim terms "operable to" to be a positive recitation. Office Action, page 2, ¶ 2. Attorney for Applicants discussed this issue with the Examiner in a telephone conference on November 16, 2005 and agreed, at the Examiner's suggestion, to amend the claims reciting this term to recite "configured to." Applicants have made these amendments herein.

Section 112 Rejections

Claims 1-25, 33-34, 48-49 and 55 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended Claims 1, 13-14, 33-34, 48-49 and 55 in response to these rejections. Applicants thus respectfully request that the rejections of Claims 1-25, 33-34, 48-49 and 55 under 35 U.S.C. §112, second paragraph, be withdrawn.

Sections 102/103 Rejections

Claims 1-2, 6-8, 11-14, 19-21, 24-26, 28-31, 37, 40-41, 43-46 and 52 and 54 are rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6684329 issued to Epsteine et al. ("*Epsteine*"). Applicants respectfully traverse these rejections.

With respect to Claims 1, 13-14, 26 and 40-41, the Office Action states that *Epsteine* does "not explicitly teach that the data filtering is the implementation of an agreement between a first and second entity." Office Action, page 4, ¶ 12. The Office Action additionally states:

However, business entities are inherently engaged in information exchange either within the organization (*e.g. between departments*) or involving other organizations (*e.g. business partners*) and as a result data exchange is customized based on the nature of the relationship between entities (in other words agreement is used to validate data exchange).

Even if data exchange were not customized based on the nature of the relationship between entities it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement the agreement between a first and second entity to filter data (*e.g. disallow communication of the data that violates the agreement*). One of ordinary skill in the art would have been motivated to perform such a modification in order to accommodate different data exchange requirements resulting from different business relationships between business entities.

Office Action, page 4, ¶ 12. Thus, the Office Action concedes that *Epsteine* does not explicitly disclose, for example, disallowing communication of data from a first virtual private proxy associated with a first entity to a second virtual private proxy associated with a second entity when the data violates an agreement between the first entity and the second entity.

The Office Action then suggests that these elements are either disclosed inherently in *Epsteine* or are obvious in view of *Epsteine*. Applicants note that:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

M.P.E.P. § 2112; *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q. 1461, 1464 (Bd. Pat. App. & Inter. 1990). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic. M.P.E.P. § 2112. In rejecting Claims 1, 13-14, 26 and 40-41, the Office Action has not provided a basis to reasonably support the determination that an agreement between the inside network 210 and the outside network 220 and the claimed steps related to such an agreement necessarily flow from the teachings of *Epsteine*.

For example, *Epsteine* discusses the application of its teachings in the context of trusted and untrusted networks and malicious software, intrusions and attackers from outside networks. *See Epsteine*, col. 1, lines 15-26 and col. 2, lines 11-34. It does not necessarily flow that an agreement exists between the inside network and the malicious software and attackers of outside networks of *Epsteine*. Thus, Applicants respectfully submit that *Epsteine* does not disclose each element of Claims 1, 13-14, 26 and 40-41 by inherency or otherwise.

As indicated above, the Office Action also contends that it would have been obvious to one of ordinary skill "to implement the agreement between a first and second entity to filter data (e.g. disallow communication of the data that violates the agreement . . . in order to accommodate different data exchange requirements resulting from different business relationships between business entities." Office Action, page 4, ¶ 12. However, the Office Action does not cite to any portion of any prior art that specifically motivates this combination with Epsteine.

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a modification of a reference. According to the M.P.E.P., "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. The fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination or modification. *See id.*

The Office Action provides no support in the cited art for its contention that it would have been obvious for one skilled in the art to implement an agreement between a first and second entity to filter data in order to accommodate different data exchange requirements resulting from different business relationships between business entities. In fact, *Epsteine teaches away* from such a modification. Applicants note that a prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02. *Epsteine* is directed to increasing protection in firewall

systems between trusted and untrusted networks. *Epsteine* states its intention to protect a trusted network from malicious software, intrusions and attackers from outside, untrusted networks. See *Epsteine*, col. 1, lines 15-26 and col. 2, lines 11-34. The specific intent to protect against malicious software and attackers from untrusted networks specifically teaches away from a modification requiring an agreement between the trusted network and the untrusted network that regulates the communication of data between the trusted network and the untrusted network. Therefore, Applicants respectfully submit that there is no citation to the specific teaching in the cited art that would motivate the modification suggested in the Office Action as required by the M.P.E.P. and governing Federal Circuit caselaw and that *Epsteine* specifically teaches away from such a modification.

Therefore, for at least the reasons discussed above, Applicants respectfully submit that Claims 1, 13-14, 26 and 40-41 are patentable over the cited art used in the rejections and request that the rejections of Claims 1, 13-14, 26 and 40-41 be withdrawn.

Claims 2, 6-8 and 11-12 depend, either directly or indirectly, from Claim 1; Claims 19-21 and 24-25 depend, either directly or indirectly, from Claim 14; Claims 28-31 and 37 depend, either directly or indirectly, from Claim 26; and Claims 43-46, 52 and 54 depend, either directly or indirectly, from Claim 41. Therefore, for at least the reasons discussed above with respect to Claims 1, 14, 26 and 41, Applicants respectfully submit Claims 2, 6-8, 11-12, 19-21, 24-25, 28-31, 37, 43-46, 52 and 54 are patentable over the cited art used in the rejection and request that the rejections of these claims be withdrawn.

Claims 9 and 22 are rejected under 35 U.S.C. §103(a) as obvious over *Epsteine*. Applicants respectfully traverse these rejections. Claim 9 depends indirectly from Claim 1, and Claim 22 depends indirectly from Claim 14. Therefore, for at least the reasons discussed above with respect to Claims 1 and 14 Applicants respectfully submit Claims 9 and 22 are patentable over the cited art used in the rejection and request that the rejections of these claims be withdrawn.

Claims 3-5, 15-18, 38-39 and 53 are rejected under 35 U.S.C. §103(a) as unpatentable over *Epsteine* in light of U.S. Patent No. 6073242 issued to Hardy, et al. ("Hardy") and in

view of U.S. Patent No. 6308276 issued to Ashdown, et al. ("Ashdown"). Applicants respectfully traverse these rejections. Claims 3-5 depend, either directly or indirectly, from Claim 1; Claims 15-18 depend, either directly or indirectly, from Claim 14; Claims 38 and 39 depend, either directly or indirectly, from Claim 26 and Claim 53 depends from Claim 41. Therefore, for at least the reasons discussed above with respect to Claims 1, 14, 26 and 41, Applicants respectfully submit Claims 3-5, 15-18, 38-39 and 53 are patentable over the cited art used in the rejection and request that the rejections of these claims be withdrawn.

Claims 10, 23, 27, 32-36, 42 and 47-51 are rejected under 35 U.S.C. §103(a) as unpatentable over *Epsteine* in light of U.S. Pub. 20020178103 issued to Dan, et al. ("Dan"). Applicants respectfully traverse these rejections. Claim 10 depends indirectly from Claim 1; Claim 23 depends indirectly from Claim 14; Claim 27 and 32-36 depend, either directly or indirectly, from Claim 26; and Claims 42 and 47-51 depend, either directly or indirectly, from Claim 41. Therefore, for at least the reasons discussed above with respect to Claims 1, 14, 26 and 41, Applicants respectfully submit Claims 10, 23, 27, 32-36, 42 and 47-51 are patentable over the cited art used in the rejection and request that the rejections of these claims be withdrawn.

Claim 55

Applicants note that the Office Action does not provide any prior art grounds for rejecting of Claim 55. Applicants respectfully request allowance of Claim 55.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants


Chad C. Walters
Reg. No. 48,022

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Correspondence Address:

PTO Customer Number

38,501